

REMARKS

Applicant has received and reviewed the Final Action mailed by the Office on 21 April 2006 (the "Final Action"), and submits this response to the Final Action with a request for continued examination (RCE). Applicant requests favorable consideration of this response.

Claims 1, 3, 11, 13, 19, and 21-23 are pending in the present application. Claims 1, 11, and 19 have been amended to clarify claimed subject matter and/or correct informalities. No new matter has been introduced by these amendments. Support for the amendments can be found in the original specification at least at page 8, paragraph [0017]; page 9, paragraph [0018]; and Figures 4A and 8A.

Claims 21-23 are newly added. Support for the claim additions can be found in the original specification at least at page 2, paragraph [0003]; and Figures 11 and 13. Claims 21-23 are presented to provide additional scope of protection commensurate with the original disclosure.

Applicant requests favorable consideration of this response and allowance of the subject application based on the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 3, and 19 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by U.S. Patent No. 5,738,654 to Tihon. Applicant respectfully traverses this rejection.

Independent Claim 1 has been amended, which is directed to a fish tape, recites:

*A fish tape, comprising:
a longitudinal portion comprising a circular outer diameter, wherein the circular outer diameter, and defining a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape*

comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion;

wherein the longitudinal portion of the fish tape comprising the plurality of spiral grooves and the plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape; and

an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment.

In setting forth a ground of rejection, the Office cited Figure 5 of Tihon, an elongate plastic member having an outer diameter of 0.21 inches and a plurality of spiral grooves (see Final Action, page 2).

This evidence does not disclose expressly or inherently “*a solid substantially cylindrical shape, and to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape*”, as recited in Claim 1. Rather, Tihon is a drainage device having an inner drain tube. For example, several of Tihon’s Figures, including Fig. 5, show a lumen 18 within Tihon’s inner drain tube. Additionally, Tihon illustrates a nylon line 25 passing apparently through this lumen 18. For convenience, Applicant reproduces here Figure 5 of Tihon.

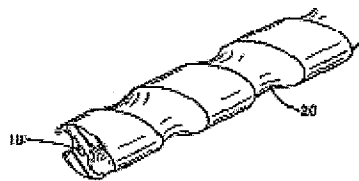


FIG. 5

Thus, Tihon does not disclose the solid fish tape as recited in Claim 1.

Furthermore, the Office stated the device is capable of performing the intended use recited in the claims, i.e., is capable of functioning as a fish tape (Action, page 2). Applicant

respectfully disagrees, for at least the reasons set forth below in response to the rejections based on 35 U.S.C. § 103(a).

Consequently, Applicant respectfully submits that Claim 1 is not anticipated by Tihon and requests that the §102 rejection be withdrawn.

Dependent Claim 3 depends from Claim 1, and thus is allowable as depending from an allowable base claim.

Independent Claim 19 is amended to recite features similar to those in Claim 1 and hence benefits from the same arguments directed above to Claim 1. Applicant asserts Tihon fails to anticipate independent Claims 1 and 19 because Tihon does not disclose the recited features of the claimed subject matter. Accordingly, Applicant requests withdrawal of the §102 rejections of these claims.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 11 and 13 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tihon. Applicant respectfully traverses these rejections.

Independent Claim 11, which is directed to a fish tape device, recites in part:

"A fish tape device, comprising:

a fish tape comprising:

a longitudinal portion comprising a circular outer diameter, wherein the circular outer diameter ranges from about 0.1875 inches to about 0.375 inches, and defining a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion;

wherein the longitudinal portion of the fish tape comprising the plurality of spiral grooves and the plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape; and

an end portion comprising a spiral groove extending from the end portion partially along the longitudinal portion, wherein the spiral groove provides one or more mechanisms for attachment; and

a reel assembly for receiving the fish tape.

In setting forth a ground of rejection, the Office relies on Figure 5 and Prior Art Figure 1 of the instant case, which shows how an elongate flexible member may be stored in a reel (Action, page 2).

Applicant traverses the rejection of Claim 11 because Tihon is non-analogous art. For the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute “analogous art” (MPEP §2141.01(a)). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved.

Regarding the first prong of the above analysis, Tihon is not from the same field of endeavor as the Applicant’s subject matter. Tihon is directed to a self cleansing bladder drainage device. Tihon’s device has channels for urine to drain to a reversibly detachable collection segment. In contrast, Applicant’s subject matter pertains to fish tapes used to pull wires through conduits or other raceways. Thus, Tihon is clearly not from the same field of endeavor as is Applicant’s subject matter.

Turning now to the second prong of the above analysis, Tihon is not reasonably pertinent to the particular problem with which Applicant is involved. As noted above, Tihon is directed to a self-cleansing bladder drainage device. In contrast, the Applicant’s subject matter pertains to using fish tapes to pull wires through conduits or other raceways. Even assuming that Tihon’s bladder drainage device is threaded through a patient’s urinary tract during medical procedures, Tihon’s device does not address the problem of pulling anything back through the urinary track afterwards. As such, Tihon is not reasonably pertinent to the particular problem addressed by the Applicant.

Because it fails both prongs of the above analysis, Tihon is non-analogous art, and any §103 rejection based on Tihon is improper. On at least this basis, the Applicant requests reconsideration and withdrawal of the stated § 103 rejections of Claim 11.

Claim 13 depends directly from independent Claim 11. Thus, the comments directed above to Claim 11 apply equally to Claim 13. Accordingly, Applicant requests reconsideration and withdrawal of the §103 rejections of Claims 11 and 13.

New Claims

Claims 21-23 are newly added. Support for the claim additions can be found in the original specification at least at page 2, paragraph [0003]; and Figures 11 and 13. Claims 21-23 are presented to provide additional scope of protection commensurate with the original disclosure.

Conclusion

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present application. If any issues remain that preclude issuance of the application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

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